

II. General Remarks Concerning This Response

Claims 21-38 are currently pending. In this response, no claims are amended; no claims are added; and no claims are canceled. Reconsideration of the claims is requested.

5 The Office action objected to the specification as having an improper copyright notice; the paragraph has been amended to present a proper copyright notice.

III. Rejections over *JavaServer Pages*[™] Specification Vers. 1.1

10 The Office action has rejected all of the claims in some manner in view of Pelegri-Llopart et al., *JavaServer Pages*[™] Specification Vers. 1.1, Sun Microsystems, Inc., 08/18/1999 (JSP 1.1). The rejection is traversed.

Applicant respectfully asserts that Applicant completed and
15 reduced to practice the claimed invention before the publication of JSP 1.1 (August 18, 1999). A declaration, pursuant to 37 C.F.R. § 1.131, has been duly executed by Shane Claussen, an inventor of the present invention; the declaration was included with Applicant's previous response, and reconsideration of the
20 declaration is kindly requested. The inventor declares that Applicant's claimed invention was completed and reduced to practice prior to August 18, 1999. Exhibit "A" to the inventor's declaration is an IBM Invention Disclosure Form that disclosed Applicant's claimed invention. This Disclosure was submitted to
25 the IBM Intellectual Property Law Department in Austin, Texas prior to August 18, 1999. The inventor's declaration under 37 C.F.R. § 1.131, therefore, removes JSP 1.1 from consideration as prior art. Because JSP 1.1 should not be considered with respect to Applicant's claimed invention, the rejection fails to make a
30 *prima facie* case of obviousness in rejecting the pending claims. Applicant respectfully asserts that the claims are allowable.

IV. Arguments in support of Applicant's 1.131 Declaration

The Office action raises multiple issues with respect to Applicant's previously submitted declaration under 37 C.F.R. § 1.131, which the Office action describes as "ineffective".

The Office action states the following on pages 2 and 3:

Applicant's affidavit must disclose the claimed invention and the applicant should explain how the IBM disclosure corresponds to the specific claims. For example, the applicant claim cites limitations such as generating a DOM tree, processing the DOM tree to represent a web page, replacing custom tags in the DOM tree, and processing the DOM tree to generate a servlet having a method call that is generated as a result of processing the script, wherein execution of the method call invokes the method in the Java object, etc., are not disclosed in the "Idea of a Disclosure" statement. Applicant is requested to map out exactly how the claim limitations are comprehended in the IBM disclosure.

The features that are paraphrased by the Office action are fairly representative of the claimed features within the independent claims, e.g., using independent claim 21 as an exemplary claim:

21. A process for serving a web page, the process comprising the steps of:
prior to receiving a request for the web page, generating a Java object that implements an interface that defines a method for performing a function against an element in a Document Object Model (DOM) tree representing the web page;
in response to receiving an initial request for the web page:
generating a DOM tree representing the web page;
replacing a custom tag in the DOM tree with a script;
processing the DOM tree to generate a servlet having a method call that is generated as a result of processing the script, wherein execution of the method call invokes the method in the Java object;
in response to receiving the initial request or a subsequent request for the web page:
executing the servlet; and
invoking the method in the Java object.

Applicant first notes that some of the claim elements or portions of the claim elements that are mentioned within the statement of the Office action are not at issue because they are not argued as being novel by Applicant nor presented by Applicant within the specification as being novel. For example, the features of "generating a DOM tree", "processing the DOM tree to represent a web page", and "processing the DOM tree to generate a servlet having a method call" were not novel at the time of the present invention. In most patent claims, various claim elements may provide context for the novel claim elements, whereas other features in the claims may be prior art at the time of the invention which is included within the claim as support. In other words, certain claim elements can be regarded as being novel, and the claim as a whole can be regarded as being novel because it is an improvement of a previously known process or a previously known device by having the inclusion of the novel elements. Thus, the Office action's objection is misguided; the disclosure document only needs to disclose the features that the Applicant regards as being novel, and the disclosure document should not be expected to disclose anything and/or everything that was known as prior art at the time of the invention.

Hence, Applicant disagrees that the novel claim elements are not found within the disclosure document. The disclosure document states the following in its "Idea of disclosure" section:

Our experience has shown that custom tag beans often result in a large amount of Java code being generated into the resulting servlet. Since this code is largely common across servlets generated from the same tag bean (variable names might change, but little else), the code can be factored into a separate JavaBean, and the tag bean need only generate enough Java code for the servlet to call out

to the separate bean. This dramatically reduces the code in the tag bean handler, and greatly simplifies debugging; thus it increases maintainability of the code. In addition, as a separate JavaBean, you would be more inclined to add extra error handling code which would be too cumbersome to generate.

The novel feature of "replacing a custom tag in the DOM tree with a script" is found in the disclosure document by the following statements:

[C]ustom tag beans often result in a large amount of Java code being generated into the resulting servlet. Since this code is largely common across servlets generated from the same tag bean (variable names might change, but little else), the code can be factored into a separate JavaBean.

The novel feature of "... a method call that is generated as a result of processing the script, wherein execution of the method call invokes the method in the Java object" is found in the disclosure document by the following statement: "the tag bean need only generate enough Java code for the servlet to call out to the separate bean". Since the disclosure document does disclose the novel features of the present invention, the assertion in the Office action about the disclosure document is incorrect.

The Office action further states:

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Eduardo Peligri-Lopart et al., JavaServer Pages™ Specification (Version 1.1 Public Release, August 18, 1999) reference.

It is unclear and confusing why this statement is included within the Office action. Applicant has provided evidence to show that the present invention was conceived and reduced to practice before the published reference.

It is also unclear if the Office action is objecting to the disclosure document as not providing sufficient evidence of a physical reduction to practice. It should be noted that the disclosure document provides evidence of a constructive reduction to practice in the same manner that the specification document of a patent application provides evidence of a constructive reduction to practice. Moreover, the disclosure document provides evidence of a conception of the invention prior to the effective date of the 08/18/1999-published reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application, as stated in 37 CFR 1.131.

The Office action also requests further information using the following statement:

Applicant states that the deleted dates from Exhibit A are prior to August 18, 1999. Examiner points out that page 2 of the IBM disclosure cites a date of 12/99 for JSPx or XSP product. An explanation of why the disclosure cites a date that is after the August 18th, 1999 date of Disclosure would be appreciated.

The date to which the Office action is referring is found in the "Critical Questions" section of the disclosure document in "Question 3", which reads in part: "Is a sale, use in manufacturing, product announcement, or proposal planned?" The disclosure document shows that the "Yes" option for this question was selected. The disclosure document then contains the following statement: "If Yes, identify the product if known and indicate the date or planned date of sale, announcements, or proposal and to whom the sale, announcement or proposal has been or will be made." In response, over multiple lines, the disclosure document reads:

WebSphere
3.x
JSPx or XSP
12/1999
IBM Internal

5 It is unclear why the Office action requests an explanation of
the "12/1999" date. At a date prior to August 18, 1999, it was
expected that the invention that was disclosed within the
10 disclosure document would be included in an IBM product (IBM is
the assignee of the present invention) at a time approximately
around December 1999. The "12/1999" date is irrelevant with
respect to the 08/18/1999 date of publication of the reference
that has been used in a rejection of the present invention; it is
15 a future date that is after the 08/18/1999 date. The fact that
the disclosure document mentions a date after the 08/18/1999 is
irrelevant. The relevant facts are that the claimed invention
was constructively reduced to practice at a date prior to the
08/18/1999 publication date as evidenced by the disclosure
20 document, which was created prior to 08/18/1999; these facts are
declared as truthful by the inventor. Whether or not the present
invention was actually included within the specified product at a
date after the 08/18/1999 publication date is irrelevant.

25 The Office action also requests further information using
the following statement:

Examiner requests Applicant to present any disclosures,
publications, or sales information that have been cited in
the IBM Invention Disclosure on pages 2-3 to conform with 37
CFR 1.105.

30 Applicant declines to provide further information at this time
because Applicant asserts that the Office action's inclusion of a
requirement under 37 CFR 1.105 for additional information is
unreasonable for the following reasons and/or other reasons.

First, MPEP 704.11 states: "The criteria in 37 CFR 1.105 for making a requirement for information is that the information be reasonably necessary to the examination or treatment of a matter in an application." Applicant asserts that there is no issue or matter in the present application such that the examination of the present application would be assisted by additional information. The Office action contains a statement in which it appears that the Office action considered the 12/1999 date to be relevant, but as explained above, the 12/1999 date is irrelevant.

Second, MPEP 704.11 states: "There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter." Applicant asserts that there is no reasonable basis for the 1.105 request for information. The Office action contains a statement that shows confusion with respect to the outstanding relevant issues, particularly the dates that are relevant to the issue of the reduction to practice of the present invention and the publication date of a reference that partially forms the basis for the pending rejection of the claims in the present patent application. The 12/1999 date that is mentioned in the disclosure document is a date when it was expected that the invention that was disclosed within the disclosure document would be included in an IBM product (IBM is the assignee of the present invention) at a time approximately around December 1999. As noted above, whether or not the present invention was actually included within the specified product at a date after the 08/18/1999 publication date is irrelevant. The fact of whether or not there were "any disclosures, publications, or sales information" related to this mentioned product is irrelevant and does not provide a reasonable basis for requesting such information.

Third, the statement in the Office action is misleading:

"Examiner requests Applicant to present any disclosures, publications, or sales information that have been cited in the IBM Invention Disclosure on pages 2-3 ...". Applicant asserts
5 that the disclosure document does not cite such information; the disclosure document requests that the inventor provide such information as is known to the inventor at the time that the inventor creates the disclosure document, and the inventor did not cite "any disclosures, publications, or sales information."

10 Fourth, the fact that there may have been some intention on the part of the assignee to prospectively include the present invention in a future product does not necessarily imply that the present invention was described within "any disclosures, publications, or sales information" in any useful manner in any
15 additional information within the relevant time frame, i.e. around the 08/18/1999 publication date of the applied reference.

Fifth, the disclosure document clearly contains information that negates the 1.105 requirement for additional information. The disclosure document clearly cites "the identified product" as
20 being "IBM internal". Given that the disclosure document states that the product is to be "IBM internal", there is no reasonable basis for assuming that there were "any disclosures, publications, or sales information" that were external to IBM and available to parties other than IBM around the 08/18/1999
25 publication date of the applied reference.

Sixth, Applicant asserts that the 1.105 requirement for additional information in the Office action appears to be an exercise to obtain additional information that hypothetically might raise an additional issue of an on-sale bar to the
30 patentability of the present invention or for some other similar issue. It should be self-evident that an attempt to obtain

information in order to create an additional examination issue does not assist in the resolution of existing examination issues.

Seven, Applicant asserts that the 1.105 requirement is so vague and unclear in its present form that Applicant is not able to comply with the requirement. Applicant cannot comply with the requirement in the Office action that Applicant "... present any disclosures, publications, or sales information that have been cited in the IBM Invention Disclosure on pages 2-3 ..." because no such information is cited. Applicant notes that the MPEP requires that a 1.105 requirement should be "narrowly defined". Given that it is unclear what additional information Applicant could present to clarify the issues concerning the 08/18/1999 publication of the applied reference, Applicant requests a clarification of the requirement if the 1.105 requirement is maintained.

V. Applicant's Declaration as Evidence of Derivation of Work

MPEP 2132.01 states:

When the reference is not a statutory bar under 35 U.S.C. 102(b), (c), or (d), applicant can overcome the rejection by swearing back of the reference through the submission of an affidavit under 37 CFR 1.131. *In re Foster*, 343 F.2d 980, 145 USPQ 166 (CCPA 1965). If the reference is disclosing applicant's own work as derived from him or her, applicant may submit either a 37 CFR 1.131 affidavit to antedate the reference or a 37 CFR 1.132 affidavit to show derivation of the reference subject matter from applicant and invention by applicant. *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

As discussed hereinabove, Applicant has submitted evidence that Applicant's conception of the claimed invention antedates the applied reference. In addition, **Applicant also asserts that it is unclear why the Office action has failed to consider that**

the pending obviousness rejection is improperly based on

Applicant's own work. The pending rejection in the outstanding Office action is an obviousness rejection under 35 U.S.C.

§103(a). Any reference that is applied in a rejection under 35

5 U.S.C. §103(a) must be qualified as a prior art reference under one of the sections of 35 U.S.C. § 102. The applied JSP 1.1

reference qualifies as prior art under 35 U.S.C. § 102(a) because the JSP 1.1 reference is a printed publication with a publication date prior to the filing date of the present patent application.

10 However, Applicant can overcome a rejection based on the JSP 1.1 reference because the JSP 1.1 reference is derived from

Applicant's own work.

Applicant's previously submitted affidavit clearly contains information sufficient to "to show derivation of the reference

15 subject matter from applicant and invention by applicant" as

stated in MPEP 2132.01. Although Applicant's previously submitted affidavit is titled as a 1.131 affidavit and MPEP

2132.01 requests a 1.132 affidavit, a 1.132 affidavit is merely a catch-all section that provides support for submission of

20 affidavits that are not otherwise "not provided for" in other regulatory sections; thus, the title of the affidavit is relevant

to the other pending issues and irrelevant to the issue of

derivation of work. Hence, Applicant has properly submitted

evidence to rebut the *prima facie* case that the JSP 1.1 reference

25 describes work only "by others"; the JSP 1.1 reference clearly

describes work by Applicant as noted in paragraph #4 of the affidavit and as acknowledged within the JSP 1.1 reference. In

other words, the relevant portions of the JSP 1.1 reference are derived from Applicant's own work. Applicant asserts that the

30 burden of proof and/or the burden of production of evidence has been shifted from Applicant back onto the Patent Office to

provide prove and/or to provide evidence that the JSP 1.1
reference is work only "by others" that does not include
Applicant. Without such a showing by the Patent Office,
Applicant asserts that the rejection has been overcome and that
5 the rejection should be withdrawn.

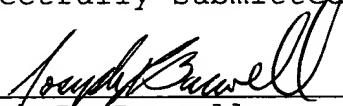
VI. Conclusion

It is respectfully urged that the present application is
patentable, and Applicant kindly requests a Notice of Allowance.

10 For any other outstanding matters or issues, the examiner is
urged to call or fax the below-listed telephone numbers to
expedite the prosecution and examination of this application.

DATE: January 10, 2005

Respectfully submitted,



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